

**REMARKS**

Please reconsider the Application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this Application. In the Office Action, the Examiner rejected claims 3-15, 17, and 18 under 35 U.S.C. §103(a) as unpatentable over United Kingdom Patent Specification No. 1,596,330 ("Thompson") and U.S. Patent No. 6,062,313 ("Moore"). In response, Applicant hereby requests the Application be Amended as described herein and respectfully traverses.

**Summary of Amendments**

By this paper, Applicant hereby requests amendment of independent claims 3, 13, and 17 to more clearly define the claimed subject matter. Particularly, the claims are amended to recite the de-gasifying of hydrocarbons to produce oil and separated gas. Applicant respectfully asserts that support for the claim amendments may be found in the abstract, paragraphs [0057] and [0058] of the specification, and Figures 9 and 10, such that no new matter is added. Furthermore, Applicant respectfully asserts that no additional search is necessary to examine the claims as amended.

**Claims 3-15, 17, and 18 not obvious under 35 U.S.C. §103(a)**

In the Office Action, the Examiner proposed a combination of Thompson with Moore to reject the subject matter of independent claims 3, 13, and 17. In response, Applicant respectfully traverses the rejection on the ground that Moore is non-analogous and one of ordinary skill in the art would lack the motivation to combine the two to arrive at the invention as claimed. Furthermore, the applicant asserts that even if such motivation is found, the proposed combination

would not disclose each and every element of the invention as arranged in amended claims 1 and 13, and 17.

The Federal Circuit has ruled that “[i]n holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.” *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001). Further, there must be “some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). There is no such teaching, suggestion, or generally available knowledge in the prior art to combine Thompson and Moore references as proposed.

Furthermore, use of the present application as a "road map" for selecting and combining prior art disclosures is wholly improper. See MPEP § 2143; *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985) (stating that "[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time"); *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992) (stating that "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . . . This court has previously stated that 'one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"); *In re Wesslau*, 353 F.2d 238 (C.C.P.A. 1965) (stating that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it

as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art").

In response, Applicant hereby re-asserts the arguments proffered in support of Applicant's response to the Office Action dated December 12, 2005 regarding the impropriety of the proposed combination of Moore with Thompson for Moore being non-analogous and for lacking motivation to combine. Particularly, Moore relates to *drilling* operations while the Applicant's invention relates to apparatus and methods for reducing the infrastructure needed to produce oil and gas from remote offshore environments. As such, drilling a borehole into an earth formation using fluids is an entirely different function than producing fluids from the borehole and transporting them to market. Therefore, drilling and production operations are not considered to be within the same field of endeavor "merely because they both relate to the petroleum industry." *In re Clay*, 996 F.2d 656, 659; 23 USPQ2d 1058 (Fed. Cir. 1992). Furthermore, as amended, the proposed combination of Moore with Thompson fails to disclose, teach, or suggest all of the claim limitations as claimed, thereby failing the "all elements" test. Particularly, the proposed combination does not disclose a) de-gasifying hydrocarbons obtained from the sub-sea hydrocarbons field to *produce oil and separated gas*; and b) conveying the *separated gas* to the vessel and the *produced oil* to a storage tank on a seabed.

In responding to Applicant's prior arguments, the Examiner noted that no claim limitations supporting Applicant's traversal of Moore on the basis that the separation of gas was merely "temporary" were present. (Final Office Action, Pg. 7). Furthermore, it is respectfully believed that the Examiner indicated that Applicant's arguments would be persuasive if claim

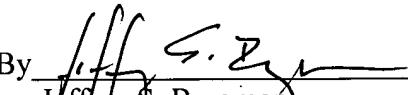
limitations to specify that the separation of gas from hydrocarbons as not being “temporary” were added to the rejected claims. Therefore, as described above, independent claims 3, 13, and 17 are amended herein to incorporate the limitation “separated gas.”

Amended claim 3 now recites de-gasifying hydrocarbons obtained from the sub-sea hydrocarbons field to produce oil and *separated* gas. As such, because both oil and *separated* gas are *produced*, the separation may not be presumed to be temporary. Additionally, amended claim 3 further recites conveying the *separated* gas to the vessel and the produced oil to a storage tank on a seabed. As such, the conveyance of *separated* gas to a vessel prohibits such separation from being presumed or considered temporary. Furthermore, amended claim 13, now recites a sub-sea separation system configured to de-gasify hydrocarbons to produce oil and *separated* gas. Similarly, amended claim 17 now recites a means for de-gasifying hydrocarbons obtained from the sub-sea hydrocarbons field to produce oil and *separated* gas. As such, the proposed combination of Moore with Thompson fails to disclose, teach, or suggest the invention as claimed in independent claims 3, 13, and 17 as any degasification of gases from fluids therein would merely be temporary.

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 06558/011002).

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Respectfully submitted,

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